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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,088	09/19/2001	Tatsumi Matsumoto	016907-1295	9778
22428	7590	02/10/2006	EXAMINER	
FOLEY AND LARDNER LLP			MILIA, MARK R	
SUITE 500			ART UNIT	
3000 K STREET NW			PAPER NUMBER	
WASHINGTON, DC 20007			2622	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,088

Applicant(s)

MATSUMOTO, TATSUMI

Examiner

Mark R. Milia

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/14/05 and has been entered and made of record. Currently, claims 1-16 are pending.

Drawings

2. Applicant's amendment to Figures 2, 4, and 5 and to the corresponding areas of the specification has overcome the objection to the Drawings as cited in the previous Office Action. Therefore the objection has been withdrawn.

Specification

3. Applicant's amendment to correct minor informalities on pages 13 and 15 overcome the objection to the specification as cited in the previous Office Action. However, as stated in the previous Office Action, on page 9, line 22, reference character "28" should read "26". Therefore the specification is still objected to.

Response to Arguments

4. Applicant's arguments with respect to claims 1-16, more specifically claims 1, 8, and 11, have been considered but are moot in view of the current amendments to the claims and therefore a new ground(s) of rejection will be made. Particularly, the examiner agrees that Matsumoto fails to disclose not moving the trays after receiving the paper discharged from the discharge port. However, Asahi does disclose such a feature as the reference states that output bins are moved into a certain position based on the operation mode selected by the user. Asahi does not state that the bins move back to a "home" position or any other position after paper has been received. Further, Asahi suggests that the invention can be applied to fixed-bin type devices, which shows that Asahi recognizes that need for a similar system that does not move bins to particular locations.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asahi in view of Canon imageRUNNER5000 Series User's Guide.

Regarding claim 1, Asahi discloses an image forming apparatus comprising: an original document table which sets an original document (see Fig. 3 and paragraph

[0027] lines 1-3), a read section for a copy mode to optically read an image of the original document set on the original document table (see Fig. 1, paragraph [0024] lines 2-4, and paragraph [0031]), an input section for a printer mode, which is inputted with an image transferred from outside (see Fig. 1, paragraph [0021] lines 4-10, paragraph [0023] lines 1-3, and paragraph [0024] lines 3-7), a print section which prints the image read the read section and the image inputted to the input section, on a paper sheet (see Figs. 1 and 2 and paragraph [0032]), a discharge port which discharges the printed paper sheet (see Figs. 1-3, paragraph [0024] lines 7-11, and paragraphs [0025], [0031], and [0033]), a sorter having a tray for the copy mode and a tray for the printer mode, which can move freely to a position corresponding to the discharge port, to receive the paper discharged from the discharge port, on any one of the trays (see Fig. 2 and paragraphs [0025] and [0033]), a first key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), a second key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), a control section which executes control of a first copy mode in accordance with an operation of the first key, control of the printer mode in accordance with an image input to the input section, and control of a second copy mode in accordance with an operation of the second key (see Fig. 1, paragraph [0022] lines 8-10, and paragraphs [0025] and [0033]), wherein in the control for the first copy mode, if the tray for the copy mode is set at the position corresponding to the discharge port when the first key is operated, the read section and the print section are immediately operated and the trays are not moved after the tray for the copy mode has received the paper discharged from the discharge port, and if the tray for the copy mode is not set at the

position corresponding to the discharge port when the first key is operated, the tray for the copy mode is moved to the position corresponding to the discharge port and the read section and the print section are operated after completion of trays motion and the trays are not moved after the tray for the copy mode has received the paper discharged from the discharge port (see Fig. 2 and paragraphs [0025] and [0033]), and in the control for the printer mode, if the tray for the printer mode is set at the position corresponding to the discharge port when an image is inputted to the first input section, the print section immediately operated and the trays are not moved after the tray for the printer mode has received the paper discharged from the discharge port, and if the tray for the printer mode is not set at the position corresponding to the discharge port when the image is input to the first input section, the tray for the printer mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion and the trays are not moved after the tray for the printer mode has received the paper discharged from the discharge port (see Fig. 2 and paragraphs [0025] and [0033]). Examiner would also like to note that the above claim limitations are admitted as prior art in the applicant's disclosure, as stated on pages 1 and 2.

Asahi does not disclose expressly in the control for the second copy mode, when the second key operated, the read section and the print section are immediately operated irrespective of the positions of the trays and without moving each of the trays and the trays are not moved after the tray has received the paper discharged from the

discharge port. However, Asahi does disclose that the system could be applied to a fixed-bin type sheet processing apparatus (see paragraph [0065]).

Canon User's Manual discloses the ability to designate trays for certain functions, i.e. copy, print, etc., and when all trays have the same designations the trays are not moved when a print or copy mode is selected and the paper is discharged to whichever tray is located at the discharge port (see page 6-17).

Regarding claim 8, Asahi discloses a method of controlling the image forming apparatus including an original document table which sets an original document (see Fig. 3 and paragraph [0027] lines 1-3), a read section for a copy mode to optically read an image of the original document set on the original document table (see Fig. 1, paragraph [0024] lines 2-4, and paragraph [0031]), an input section for a printer mode, which is inputted with an image transferred from outside (see Fig. 1, paragraph [0021] lines 4-10, paragraph [0023] lines 1-3, and paragraph [0024] lines 3-7), a print section which prints the image read the read section and the image inputted to the input section, on a paper sheet (see Figs. 1 and 2 and paragraph [0032]), a discharge port which discharges the printed paper sheet (see Figs. 1-3, paragraph [0024] lines 7-11, and paragraphs [0025], [0031], and [0033]), a sorter having a tray for the copy mode and a tray for the printer mode, which can move freely to a position corresponding to the discharge port, to receive the paper discharged from the discharge port, on any one of the trays (see Fig. 2 and paragraphs [0025] and [0033]), a first key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), the method comprising a step in the first copy mode, if the tray for the copy mode is set at the position corresponding to the

discharge port when the first key is operated, the read section and the print section are immediately operated and the trays are not moved after the tray for the copy mode has received the paper discharged from the discharge port, and if the tray for the copy mode is not set at the position corresponding to the discharge port when the first key is operated, the tray for the copy mode is moved to the position corresponding to the discharge port and the read section and the print section are operated after completion of trays motion and the trays are not moved after the tray for the copy mode has received the paper discharged from the discharge port (see Fig. 2 and paragraphs [0025] and [0033]), and a step in the printer mode, if the tray for the printer mode is set at the position corresponding to the discharge port when an image is inputted to the first input section, the print section immediately operated and the trays are not moved after the tray for the printer mode has received the paper discharged from the discharge port, and if the tray for the printer mode is not set at the position corresponding to the discharge port when the image is input to the first input section, the tray for the printer mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion and the trays are not moved after the tray for the printer mode has received the paper discharged from the discharge port (see Fig. 2 and paragraphs [0025] and [0033]). Examiner would also like to note that the above claim limitations are admitted as prior art in the applicant's disclosure, as stated on pages 1 and 2.

Asahi does not disclose expressly a step in the second copy mode, when the second key operated, the read section and the print section are immediately operated

irrespective of the positions of the trays and without moving each of the trays and the trays are not moved after the tray has received the paper discharged from the discharge port. However, Asahi does disclose that the system could be applied to a fixed-bin type sheet processing apparatus (see paragraph [0065]).

Canon User's Manual discloses the ability to designate trays for certain functions, i.e. copy, print, etc., and when all trays have the same designations the trays are not moved when a print or copy mode is selected and the paper is discharged to whichever tray is located at the discharge port (see page 6-17).

Regarding claim 11, Asahi discloses an image forming apparatus comprising: an original document table which sets an original document (see Fig. 3 and paragraph [0027] lines 1-3), a read section for a copy mode to optically read an image of the original document set on the original document table (see Fig. 1, paragraph [0024] lines 2-4, and paragraph [0031]), an input section for a printer mode, which is inputted with an image transferred from outside (see Fig. 1, paragraph [0021] lines 4-10, paragraph [0023] lines 1-3, and paragraph [0024] lines 3-7)), a print section which prints the image read the read section and the image inputted to the input section, on a paper sheet (see Figs. 1 and 2 and paragraph [0032]), a discharge port which discharges the printed paper sheet (see Figs. 1-3, paragraph [0024] lines 7-11, and paragraphs [0025], [0031], and [0033]), a sorter having a tray for the copy mode and a tray for the printer mode, which can move freely to a position corresponding to the discharge port, to receive the paper discharged from the discharge port, on any one of the trays (see Fig. 2 and paragraphs [0025] and [0033]), a first key (see Figs. 4-6 and paragraphs [0037], [0038],

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[0040], and [0041]), a second key (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]), control means for a first copy mode in which, if the tray for the copy mode is set at the position corresponding to the discharge port when the first key is operated, the read section and the print section are immediately operated and the trays are not moved after the tray for the copy mode has received the paper discharged from the discharge port, and if the tray for the copy mode is not set at the position corresponding to the discharge port when the first key is operated, the tray for the copy mode is moved to the position corresponding to the discharge port and the read section and the print section are operated after completion of trays motion and the trays are not moved after the tray for the copy mode has received the paper discharged from the discharge port (see Fig. 2 and paragraphs [0025] and [0033]), and control means for the printer mode in which, if the tray for the printer mode is set at the position corresponding to the discharge port when an image is inputted to the first input section, the print section immediately operated and the trays are not moved after the tray for the print mode has received the paper discharged from the discharge port, and if the tray for the printer mode is not set at the position corresponding to the discharge port when the image is input to the first input section, the tray for the printer mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion and the trays are not moved after the tray for the printer mode has received the paper discharged from the discharge port (see Fig. 2 and paragraphs [0025] and [0033]). Examiner would also like to note that the above claim limitations are admitted as prior art in the applicant's disclosure, as stated on pages 1 and 2.

Asahi does not disclose expressly control means for the second copy mode, when the second key operated, the read section and the print section are immediately operated irrespective of the positions of the trays and without moving each of the trays and the trays are not moved after the tray has received the paper discharged from the discharge port. However, Asahi does disclose that the system could be applied to a fixed-bin type sheet processing apparatus (see paragraph [0065]).

Canon User's Manual discloses the ability to designate trays for certain functions, i.e. copy, print, etc., and when all trays have the same designations the trays are not moved when a print or copy mode is selected and the paper is discharged to whichever tray is located at the discharge port (see page 6-17).

Asahi & the Canon User's Manual are combinable because they are from the same field of endeavor, printing documents to be output to different output bins depending on the type of job being processed.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the mode of forcibly discharging sheets to a particular bin as described by the Canon User's Manual with the system of Asahi.

The suggestion/motivation for doing so would have been to provide the user with greater control of the output destination as well as increase the ease of collection of the document. Asahi acknowledges the need for fixed-bin type sheet processing and it is known in the art to use function buttons to stop or lock movement of output bins to allow for fast and efficient printing as shown in the Canon User's Manual.

Therefore, it would have been obvious to combine the Canon User's Manual with Asahi to obtain the invention as specified in claims 1, 8, and 11.

Regarding claims 2, 6, and 12, Asahi and the Canon User's Manual disclose the system discussed in claims 1 and 11, and Asahi further discloses wherein the sorter has an elevation unit for moving up and down each of the trays (see Fig. 2 and paragraph [0033]).

Regarding claims 3, 7, and 13, Asahi and the Canon User's Manual disclose the system discussed in claims 1 and 11, and Asahi further discloses a control panel provided with the first and second keys (see Figs. 4-6 and paragraphs [0037], [0038], [0040], and [0041]).

Regarding claims 4 and 14, Asahi and the Canon User's Manual disclose the system discussed in claims 1 and 11, and Asahi further discloses a receiving section for a facsimile mode to receive an image which is facsimile-transmitted (see Fig. 1, paragraph [0021] lines 1-10, paragraph [0022] lines 1-2, and paragraph [0024]).

Regarding claim 5, Asahi and the Canon User's Manual disclose the system discussed in claim 1, and Asahi further discloses wherein the print section further prints the image received by the receiving section (see paragraph [0024]), the sorter further has a tray for the facsimile mode (see Fig. 2 and paragraphs [0019], [0025], and [0033]), and the sorter further executes control for the facsimile mode, and in the control for the facsimile mode, if the tray for the facsimile mode is set at the position corresponding to the discharge port when an image is received by the receiving section,

the print section is immediately operated and the trays are not moved after the tray for the facsimile mode has received the paper discharged from the discharge port, and, or if the tray for the facsimile mode is not set at the position corresponding to discharge port when the image is received by the receiving section, the tray for the facsimile mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion and the trays are not moved after the tray for the facsimile mode has received the paper discharged from the discharge port (see paragraphs [0025] and [0033]).

Regarding claim 9, Asahi and the Canon User's Manual disclose the system discussed in claim 8, and Asahi further discloses wherein the apparatus comprises a receiving section for a facsimile mode to receive image which is facsimile-transmitted (see Fig. 1, paragraph [0021] lines 1-10, paragraph [0022] lines 1-2, and paragraph [0024]), the print section further prints the image received by the receiving section (see paragraph [0024]), the sorter further has a tray for the facsimile mode (see Fig. 2 and paragraphs [0019], [0025], and [0033]).

Regarding claim 15, Asahi and the Canon User's Manual disclose the system discussed in claim 14, and Asahi further discloses wherein the print section further prints the image received by the receiving section (see paragraph [0024]), the sorter further has a tray for the facsimile mode (see Fig. 2 and paragraphs [0019], [0025], and [0033]).

Regarding claims 10 and 16, Asahi and the Canon User's Manual disclose the system discussed in claims 9 and 15, and Asahi further discloses in the control for the

facsimile mode, if the tray for the facsimile mode is set at the position corresponding to the discharge port when an image is received by the receiving section, the print section is immediately operated and the trays are not moved after the tray for the facsimile mode has received the paper discharged from the discharge port, and if the tray for the facsimile mode is not set at the position corresponding to discharge port when the image is received by the receiving section, the tray for the facsimile mode is moved to the position corresponding to the discharge port and the print section is operated after completion of trays motion and the trays are not moved after the tray for the facsimile mode has received the paper discharged from the discharge port (see paragraphs [0025] and [0033]).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art refer to the attached Notice of References Cited.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

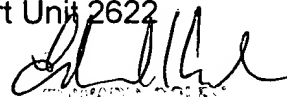
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached at (571) 272-7402. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MRM

Mark R. Milia
Examiner
Art Unit 2622



SUPPLEMENTAL EXAMINER